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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/070,936

08/09/2002

Jutta Glock

PH/5-31140A

4690

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7590

07/21/2006

SYNGENTA CROP PROTECTION, INC.  
PATENT AND TRADEMARK DEPARTMENT  
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GREENSBORO, NC 27409

EXAMINER

QAZI, SABIHA NAIM

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 07/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/070,936

Applicant(s)

GLOCK ET AL.

Examiner

Sabiha Qazi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**Non-Final Office Action**

Claims 1-7 are pending. No claim is allowed at this time.

**Summary of this Office Action dated Wednesday July 19, 2006**

1. Response to Remarks
2. Information Disclosure Statement
3. Copending Applications
4. Specification
5. 35 USC § 112 --- First Paragraph Scope of Enablement Rejection
6. 35 USC § 103(a) Obviousness Rejection – First Rejection
7. 35 USC § 103(a) Obviousness Rejection – Second Rejection
8. Communication

#### **Response to Remarks**

- Double Patenting rejection over claims 14-18 of U.S. Patent No. 6,410,480 is withdrawn because Terminal disclaimer has been filed and approved.
- Declaration was fully considered but it does not commensurate with the scope of claims. Claims are not amended to a subgenus, which is supported for synergism. Present claims are considered too broad.
- Upon further review and considerations the finality of the rejection is withdrawn. New rejections are being made.

#### **Information Disclosure Statement**

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

#### **Copending Applications**

Applicants must bring to the attention of the examiner, or other Office official involved with the examination of a particular application, information within their knowledge as to other copending United States applications, which are "material to patentability" of the application in question. MPEP 2001.06(b). See *Dayco Products Inc. v. Total Containment Inc.*, 66 USPQ2d 1801 (CA FC 2003).

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### Specification

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### Claim Rejections - 35 USC § 112 (1<sup>st</sup>)

The following is a quotation of the first paragraph of 35 U.S.C. 112:

*The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.*

Claims 1-7 rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for certain combinations such as COMBINATION OF COMPOUND 1.008 AND CLOQUITOCET-MEXYL, Tralkoxydim, fenoxaprop-ethyl and trisulfuron (pages 43 and 44 in the specification Tables B2.1 to B2.4 with oil additive MERGE) does not reasonably provide enablement for the combination of all the various classes of herbicides for example classes of compounds include pyrimidines, triazines, "as well as from the herbicides amitrol, benfuresate, bentazone, cinmethylin, clomazone, chlorypyralid, difenzoquat, dithiopyr, ethofumesate, flurochloridone, indanofane, isoxaben, oxaziclomefone, pyridate, pyridafol, quinchlorac, quinmerac, tridiphane, nlufosinate and flamprop" and many many others.

The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Compound of formula I itself include very large number of compounds due to variety of substituents defined by G, R<sub>1</sub> and R<sub>2</sub>.

The compounds represented by the formula (I) in claim 1 contain thousands of compounds, and combination of (b) such as a herbicidally effective amount of at least selected from the classes of phenoxypropionic acids, hydroxylamines, sulfonylureas, imidazolinones, pyrimidines, triazines, ureas, PPO, chloroacetanilides, phenoxyacetic acids, triazinones, dinitroanilines, azinones, carbamates, oxyacetamides, thiolcarbamates, azole-

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ureas, benzoic acids, anilides, nitriles, triones, and sulfonamides, as well as from the herbicides amitrol, benfuresate, bentazone, cinmethylin, clomazone, chlopyralid, difenzoquat, dithiopyr, ethofumesate, flurochloridone, indanofane, isoxaben, oxaziclomefone, pyridate, pyridafol, quinchlorac, quinmerac, tridiphane, nlufosinate and flamprop.

Factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. 112, first paragraph, have been described in In re Colianni, 195 USPQ 150, 153 (CCPA 1977), have been clarified by the Board of Patent Appeals and Interferences in Ex parte Forman, 230 USPQ 546 (BPAI 1986), and are summarized in In re Wands (858 F2d 731, 737, 8 USPQ2d 1400, 1404 (Fed Cir. 1988)). Among these factors are: (1) the nature of the invention; (2) the state of the prior art; (3) the relative skill of those in the art; (4) the predictability or unpredictability of the art; (5) the breadth of the claims; (6) the amount of direction or guidance presented; (7) the presence or absence of working examples; and (8) the quantity of experimentation necessary.

When the above factors are weighed, it is the examiner's position that one skilled in the art could not practice the invention without undue experimentation.

The instant invention is drawn to a selective herbicidal composition comprising (a) herbicidally effective amount of a compound of Formula I and (b) a herbicidally effective amount of at least selected from the classes of phenoxypropionic acids, hydroxylamines, sulfonylureas, imidazolinones, pyrimidines, triazines, ureas, PPO, chloroacetanilides, phenoxyacetic acids, triazinones, dinitroanilines, azinones, carbamates, oxyacetamides, thiolcarbamates,azole-ureas, benzoic acids, anilides, nitriles, triones, and sulfonamides, as well as from the herbicides amitrol, benfuresate, bentazone, cinmethylin, clomazone, chlopyralid, difenzoquat, dithiopyr, ethofumesate, flurochloridone, indanofane, isoxaben, oxaziclomefone, pyridate, pyridafol, quinchlorac, quinmerac, tridiphane, nlufosinate and flamprop.

**(1) The predictability or unpredictability of the art:**

Claimed invention is unpredictable for the following reasons. The specification discloses the combination of compound 1.008 (one compound from formula (I) and cloquitocet-mexyl with tralkoxydim, fenoxaprop-ethyl and

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trisulfuron (see tables B2.1 to B2.4 on pages 43 and 44 in specification). The compounds of (b) as in claim 1 contains compounds having variety of different structures, which surely are expected to react differently. The prediction of synergism for the combination such a large number of compounds (b) having different properties and compound of formula (I) is therefore impossible.

The amount of guidance or direction needed to enable the invention is inversely related to the amount of knowledge in the state of the art as well as the predictability in the art. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). The "amount of guidance or direction" refers to that information in the application, as originally filed, that teaches exactly how to make or use the invention. The more that is known in the prior art about the nature of the invention, how to make, and how to use the invention, and the more predictable the art is, the less information needs to be explicitly stated in the specification. In contrast, if little is known in the prior art about the nature of the invention and the art is unpredictable, the specification would need more detail as to how to make and use the invention in order to be enabling. >See, e.g., *Chiron Corp. v. Genentech Inc.*, 363 F.3d 1247, 1254, 70 USPQ2d 1321, 1326 (Fed. Cir. 2004) ("Nascent technology, however, must be enabled with a 'specific and useful teaching.' The law requires an enabling disclosure for nascent technology because a person of ordinary skill in the art has little or no knowledge independent from the patentee's instruction. Thus, the public's end of the bargain struck by the patent system is a full enabling disclosure of the claimed technology."

The "predictability or lack thereof" in the art refers to the ability of one skilled in the art to extrapolate the disclosed or known results to the claimed invention. If one skilled in the art can readily anticipate the effect of a change within the subject matter to which the claimed invention pertains, then there is predictability in the art. On the other hand, if one skilled in the art cannot readily anticipate the effect of a change within the subject matter to which that claimed invention pertains, then there is lack of predictability in the art. Accordingly, what is known in the art provides evidence as to the question of predictability. In particular, the court in *In re Marzocchi*, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971), stated:

[I]n the field of chemistry generally, there may be times when the well-known unpredictability of chemical reactions will alone be enough to create a reasonable doubt as to the accuracy of a particular broad statement put

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forward as enabling support for a claim. This will especially be the case where the statement is, on its face, contrary to generally accepted scientific principles. Most often, additional factors, such as the teachings in pertinent references, will be available to substantiate any doubts that the asserted scope of objective enablement is in fact commensurate with the scope of protection sought and to support any demands based thereon for proof.

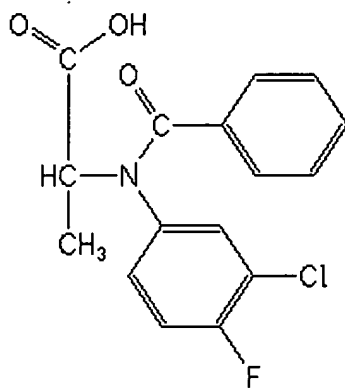
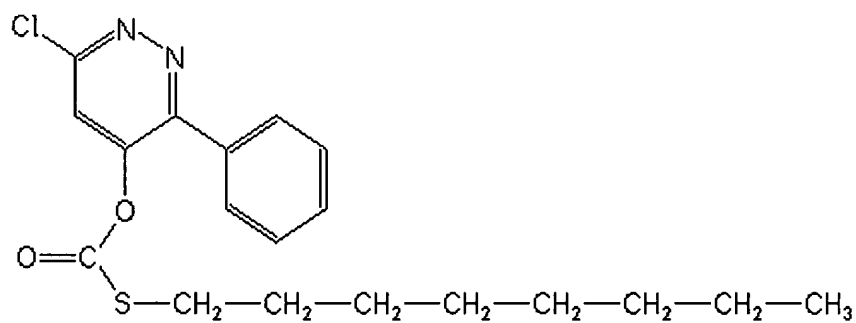
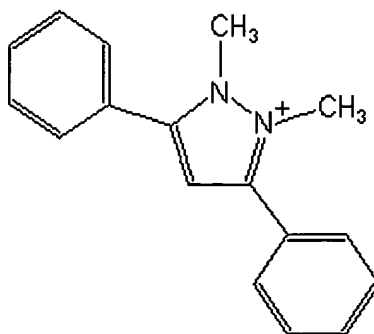
The scope of the required enablement varies inversely with the degree of predictability involved, but even in unpredictable arts, a disclosure of every operable species is not required. A single embodiment may provide broad enablement in cases involving predictable factors, such as mechanical or electrical elements. *In re Vickers*, 141 F.2d 522, 526-27, 61 USPQ 122, 127 (CCPA 1944); *In re Cook*, 439 F.2d 730, 734, 169 USPQ 298, 301 (CCPA 1971). However, in applications directed to inventions in arts where the results are unpredictable, the disclosure of a single species usually does not provide an adequate basis to support generic claims. *In re Soll*, 97 F.2d 623, 624, 38 USPQ 189, 191 (CCPA 1938). In cases involving unpredictable factors, such as most chemical reactions and physiological activity, more may be required. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970) (contrasting mechanical and electrical elements with chemical reactions and physiological activity). See also *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); *In re Vaeck*, 947 F.2d 488, 496, 20 USPQ2d 1438, 1445 (Fed. Cir. 1991). This is because it is not obvious from the disclosure of one species, what other species will work. See MPEP 2164.03.

**(2) The breadth of the claims:** The claims are broad; the compounds of formula I itself includes thousands of compounds and their combination with the multitude of different classes of herbicides which can be selected from the classes of phenoxypropionic acids, hydroxylamines, sulfonylureas, imidazolinones, pyrimidines, triazines, ureas, PPO, chloroacetanilides, phenoxyacetic acids, triazinones, dinitroanilines, azinones, carbamates, oxyacetamides, thiocarbamates,azole-ureas, benzoic acids, anilides, nitriles, triones, and sulfonamides, as well as from the herbicides amitrol, benfuresate, bentazone, cinmethylin, clomazone, chlomepyralid, difenzoquat, dithiopyr, ethofumesate, flurochloridone, indanofane, isoxaben, oxaziclomefone, pyridate, pyridafol, quinchlorac, quinmerac, tridiphane, nlfosinate and flamprop. These classes are so different from each other; it is impossible to predict any



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SYNERGISTIC activity for such compounds.. For example, the three structures shown below belong to extremely different class of chemical compounds.

**flamprop****pyridate****difenzoquat**

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**(3) The amount of direction or guidance presented:** There is no guidance in the disclosure on how THE INVENTION CAN BE USED TO PREDICT THE SYNERGISM FOR LARGE CLASSES OF HERBICIDES successfully. There is no teaching combination of the compounds of formula 1 with all the various classes of herbicides listed in part b) of claim 1.<sup>1</sup>

*See In re Dreshfield*, 110 F.2d 235, 45 USPQ 36 (CCPA 1940), gives this general rule: "It is well settled that in cases involving chemicals and chemical compounds, which differ radically in their properties it must appear in an applicant's specification either by the enumeration of a sufficient number of the members of a group or by other appropriate language, that the chemicals or chemical combinations included in the claims are capable of accomplishing the desired result."

The courts have further interpreted undue experimentation as requiring "ingenuity beyond that to be expected of one of ordinary skill in the art" (*Fields v. Conover*, 170 USPQ 276 (CCPA 1971)) or requiring an extended period of experimentation in the absence of sufficient direction or guidance (*In re Colianni*, 195 USPQ 150 (CCPA 1977)). Additionally, the courts have determined that "... where a statement is, on its face, contrary to generally accepted scientific principles", a rejection for failure to teach how to make and/or use is proper (*In re Marzocchi*, 169 USPQ 367 (CCPA 1971)).

**(4) The quantity of experimentation necessary**

Since there is no guidance and/or direction provided by the Applicants for the wide variety of the compounds and their synergistic combinations and the claims are broad, there is not sufficient guidance presented in the specification for such a large class of claimed combination of compounds for the reasons cited above, one skilled in the art would go through undue experimentation to practice the invention as claimed.

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<sup>1</sup> Examiner notes that Applicants in the specification disclose that "a specific safener will often be suitable only for a specific action with respect not only to the cultivated plants but also to the herbicide, and in some cases also subject to the mode of application, i.e. a specific safener will often be suitable only for a specific cultivated plant and a specific class of herbicide. See paragraph 3 on page 1 of the specification.

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A disclosure should contain representative examples, which provide reasonable assurance to one skilled in the art that the compounds fall within the scope of a claim will possess the alleged activity. See *In re Riat et al.* (CCPA 1964) 327 F2d 685, 140 USPQ 471; *In re Barr et al.* (CCPA 1971) 444 F 2d 349, 151 USPQ 724.

The first paragraph of 35 USC 112 requires “...*such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains...*” The instant invention fails to meet this requirement, as it lacks such full, clear, and concise manner as to enable any person skilled in the art to which it pertains to make and/or use the invention.

#### 35 USC § 103(a) Obviousness Rejection – 1<sup>st</sup> Rejection

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly

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owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over MUHLEBACH et al.<sup>2</sup> The reference teaches 3-Hydroxy-4-aryl-5-oxopyrazoline derivatives as herbicides in particular in combination with herbicide-antagonistically effective compounds which embraces presently claimed invention. The reference also teaches the use of oil in composition, it may be natural in origin or mineral. See especially page 17 for oils and surfactants.

The instant invention is drawn to a selective herbicidal composition comprising (a) herbicidally effective amount of a compound of Formula I and (b) a herbicidally effective amount of at least selected from the classes of phenoxypropionic acids, hydroxylamines, sulfonylureas, imidazolinones, pyrimidines, triazines, ureas, PPO, chloroacetanilides, phenoxyacetic acids, triazinones, dinitroanilines, azinones, carbamates, oxyacetamides, thiolcarbamates, azole-ureas, benzoic acids, anilides, nitriles, triones, and sulfonamides, as well as from the herbicides amitrol, benfuresate, bentazone, cinmethylin, clomazone, chlomepyrifos, difenzoquat, dithiopyr, ethofumesate, flurochloridone, indanofane, isoxaben, oxaziclomefone, pyridate, pyridafol, quinchlorac, quinmerac, tridiphane, nlfosinate and flumprop.

Instant claims differ from the reference in claiming a synergistic and broader combination of compounds than the prior art.

Therefore, it would have been obvious to one skilled in the art at the time invention was made to prepare additional beneficial composition because prior art teaches the combination of the structurally similar 3-Hydroxy-4-aryl-5-oxopyrazoline derivatives of formula I and other "herbicide-antagonistically effective compounds". Claimed invention also claims the combination of the compounds of formula (I) and at least one safener and/or herbicide. It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the

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<sup>2</sup> WO 99/47525. See the entire document especially abstract, compound of formula (I) on page 1, when R4 and R5 form together (Z2), examples and Tables (especially Tables 7 and 8).

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same purpose in order to form a third composition that is to be used for the very same purpose; the idea of combining them flows logically from their having been individually taught in the prior art. *In re Kerkhoven*, 205 USPQ 1069.

Since synergism cannot be predicted for such a large number of combinations of compounds and the specification does not disclose any direction for the expectation of synergism, instant invention is considered obvious over the prior art.

A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill might reasonably infer from the teachings. *In re Opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA 1976). A reference is not limited to working examples. *In re Fracalossi* 215 USPQ 569 (CCPA 1982).

Accordingly, the burden of proof is upon applicants to show that instantly claimed subject matter is different and unobvious over those taught by prior art. See *In re Brown*, 173 USPQ 685, 688; *In re Best*, 195 USPQ 430 and *In re Marosi*, 218 USPQ 289, 293.

In absence of any criticality and/or unexpected results presently claimed invention would have been *prima facie* obvious to one skilled in the art.

In the light of the forgoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the instant claims would have been obvious within the meaning of 35 U.S.C. 103(a).

### **35 USC § 103(a) Obviousness Rejection – 2<sup>nd</sup> Rejection**

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over MUHLEBACH et al. in view of HAZEN et al.<sup>3</sup> The reference MUHLEBACH teaches 3-Hydroxy-4-aryl-5-oxopyrazoline derivatives as herbicides in particular in combination with herbicide-antagonistically effective compounds which embraces presently claimed invention. The reference also teaches the use of oil in composition, it may be natural in origin or mineral. See especially page 17 for oils and surfactants.

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The instant invention is drawn to a selective herbicidal composition comprising (a) herbicidally effective amount of a compound of Formula I and (b) a herbicidally effective amount of at least selected from the classes of phenoxypropionic acids, hydroxylamines, sulfonylureas, imidazolinones, pyrimidines, triazines, ureas, PPO, chloroacetanilides, phenoxyacetic acids, triazinones, dinitroanilines, azinones, carbamates, oxyacetamides, thiolcarbamates, azole-ureas, benzoic acids, anilides, nitriles, triones, and sulfonamides, as well as from the herbicides amitrol, benfuresate, bentazone, cinmethylin, clomazone, chlopyralid, difenzoquat, dithiopyr, ethofumesate, flurochloridone, indanofane, isoxaben, oxaziclomefone, pyridate, pyridafol, quinchlorac, quinmerac, tridiphane, nlufosinate and flamprop.

The MUHLEBACH teaches the composition that has been claimed and also use of oil additives except that combination of oil additives increases the herbicidal action<sup>4</sup>.

HAZEN et al. teaches that addition of oil in composition increases the herbicidal activity (abstract). It teaches that certain crop oil concentrates enhance the activity of a broad spectrum of herbicides to an unexpected high level. Furthermore, it teaches these "same crop oil concentrates surprisingly defeat the antagonism which is often created when two or more herbicides are utilized simultaneously" (lines 58-63 in col. 1). See lines 31-57 in column 4, lines 58-65 in col. 4., the abstract, tables especially tables IX and XI and examples 1-3 in col. 4.

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time of invention was made to modify the composition of MUHLEBACH to include the additive oils as taught by HAZEN because there is a motivation to obtain enhanced herbicidal activity by adding oils. MUHLEBACH teaches the combination of the structurally similar 3-Hydroxy-4-aryl-5-oxopyrazoline derivatives of formula I and other "herbicide-antagonistically effective compounds". One having ordinary skill in the art would have been motivated to add oil in the composition to enhance the herbicidal activity because this modification would have been obvious. (See especially abstract in Hanzel). It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful

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<sup>3</sup> US Patent 4,834,908, see abstract, lines 58-63 in column 1; lines 1-2 in col. 1; lines 1-68 in col. 3 examples 1-3 lines 35-68 in col. 3.

<sup>4</sup> Even though the addition of oil has not been cited in the claims this has been addressed (Hazen et al) because the specification of present invention discloses the use of oil for increasing the herbicidal action.

for the same purpose in order to form a third composition that is to be used for the very same purpose; the idea of combining them flows logically from their having been individually taught in the prior art. *In re Kerkhoven*, 205 USPQ 1069.

Since synergism cannot be predicted for such a large number of combinations of compounds and the specification does not disclose any direction for the expectation of synergism, instant invention is considered obvious over the prior art.

A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill might reasonably infer from the teachings. *In re opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA 1976). A reference is not limited to working examples. *In re Fracalossi* 215 USPQ 569 (CCPA 1982).

Accordingly, the burden of proof is upon applicants to show that instantly claimed subject matter is different and unobvious over those taught by prior art. See *In re Brown*, 173 USPQ 685, 688; *In re Best*, 195 USPQ 430 and *In re Marosi*, 218 USPQ 289, 293.

In absence of any criticality and/or unexpected results presently claimed invention would have been *prima facie* obvious to one skilled in the art.

In the light of the forgoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the instant claims would have been obvious within the meaning of 35 U.S.C. 103(a).

#### Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha Qazi, Ph.D. whose telephone number is 571-272-0622. The examiner can normally be reached on any business day.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Johann Richter, Ph.D. can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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